



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/940,236   | 08/27/2001  | Gilbert Garitano     | DERMA-06458         | 4147             |
| 23535  | 7590        | 12/14/2004           | EXAMINER            |                  |
| MEDLEN & CARROLL, LLP<br>101 HOWARD STREET<br>SUITE 350<br>SAN FRANCISCO, CA 94105 |             |                      | DICUS, TAMRA        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1774                |                  |

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/940,236

## Applicant(s)

GARITANO, GILBERT

TA

## Examiner

Tamra L. Dicus

## Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-23 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-23 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Examiner acknowledges cancellation of claims 9-13, 24-28, and 30. Thus, the 112, 2<sup>nd</sup> paragraph rejection and the 103 rejection over Hallman et al. in view of Weberg et al. and in view of Michaels is withdrawn.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 14, and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,800,904 to Hallman et al. in view of USPN 6,203,911 to Weberg et al. as previously set forth in the Office Action of 03/24/04.

### ***Response to Arguments***

Applicant's arguments filed 09-28-04 have been fully considered but they are not persuasive. Hallman is still used to teach a filled polymeric material having a fixed image thereon. Weberg is still used in the rejection to provide for the PMMA and ATH inclusions and weight percentage ranges. Applicant argues that that the prior art does not teach a fixed image is

Art Unit: 1774

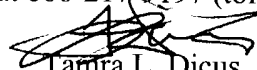
formed in (emphasis added) a filled polymeric material because while Hallman puts images into a decorative layer, applicant alleges this method is specifically not putting images into a filled polymeric material comprising a polymer and inorganic filler. The Applicant has not made a persuasive argument because Hallman explicitly teaches filled polymeric material such as filled acrylates like the same trademarked corian as applicant discloses in the specification. See col. 7, lines 53-68 of Hallman. Weberg teaches inorganic additions are known with said polymeric material. Applicant argues Hallman teaches dye sublimation processes to produce the image, thus Hallman cannot teach the instant invention. How images arrive on filled polymeric material is not afforded patentable weight as it relates to the process (further this sublimation process is not claimed). However, Applicant may not have considered Hallman teaching decorative images thereon via not only dye sublimation and printing techniques but also thermal transfer processes. See col. 8, lines 1-10 of Hallman. Hallman teaches the same process for application to the polymeric material as Applicant's "heat transfer" application as per the disclosure (pg. 13, lines 1-2 define what "fixed image formed in" means and the Examples teaching thermal transferring of images on the polymeric material). The same materials and processes are used, thus one would expect at least to some degree a fixed image is formed therein as claimed. Further, as currently presented, the claims do not limit a degree of image depth. The rejection is maintained for reasons of record. Applicant may also take notice that printing images on filled polymeric material is again, well known in the art as shown by USPN 4,406,662 to Beran et al.

Art Unit: 1774

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

December 2, 2004



RENA DYE  
SUPERVISORY PATENT EXAMINER

A.U. 1774

12/10/04